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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,813	02/06/2004	Michael Honig		9742

7590 05/17/2005  
Dr. Max Fogiel  
44 Maple Court  
Highland Park, NJ 08904

EXAMINER

JACYNA, J CASIMER

ART UNIT	PAPER NUMBER
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3751

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/773,813	<b>Applicant(s)</b> HONIG ET AL.	
	<b>Examiner</b> J. Casimer Jacyna	<b>Art Unit</b> 3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

1. The disclosure is objected to because of the following informalities: The specification is missing the headings noted in MPEP 608.01(a).

Appropriate correction is required.

2. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references teach other blow off valves with breaches and shock absorbing valves for shock absorbers.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1 is not in one sentence form. There is one complete sentence on lines 1-14 and a second complete sentence on lines 15-28. Also, the second sentence either duplicates or paraphrases the limitations in the first sentence and thereby is redundant. The double "or" clause on line 11 is not clear in that there is more than in way to interpret the double ors wherein the metes and bounds of the claim are not certain. Lines 8 and 9 clearly call for a first alternative (note the use of "either") of a groove on the outer surface of the piston rod. The end of line 9 to the first two words of line 11 ("is high") define the length of the claimed groove. The limitation following the second occurrence of "or" on line 11 clearly calls for an alternative groove (alternative to the groove on the outer surface of the piston rod), that is located in the extension and fastenings and operating components of the piston rod (see line 12). Since the limitation before the double or on 11 and the limitation after the line 11 double

or both call for alternative locations for a groove, the limitation of “the bore that extends through the piston rod” could be interpreted as an alternative third location for the claimed groove. However, since line 10 is defining the height of the first alternative groove location, the limitation of “the bore that extends through the piston rod” could also be interpreted as an alternative height for the first alternative location for the claimed groove.

Also, it is not certain if the spring loaded valve called for at the end of line 14 is only closing off the last groove of the series (the groove in the extension and fastenings and operating components of the piston rod), or if the spring loaded valve is also being claimed as closing off the first groove in the series (the groove on the outer surface of the piston rod), and possibly the possible alternative third groove in the bore that extends through the piston rod.

It is suggested that the various claimed alternative structures be clearly separated by either using separate paragraphs for each alternative, or characters such as numbers or letters. For example;

whereby the piston rod includes an undulating groove at a location selected from the group consisting of:

- a) the outer surface of the piston rod,
- b) the bore that extends through the piston rod,
- c) the piston rod extensions and fastenings and operating components.

Applicant may read MPEP 2173.05(h) for other examples of how to write alternative limitations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Casimer Jacyna whose telephone number is 571-272-4889. The examiner can normally be reached on Wed. thru Fri. 9AM-7PM, Mon. 7AM-1PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 703-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. Casimer Jacyna  
Primary Examiner  
Art Unit 3751

JCJ